

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claim 16, claims 13 to 15 and 19 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 16, 21, 23, and 25 Under 35 U.S.C. § 112**

Claims 16, 21, 23, and 25 were rejected under 35 U.S.C. § 112, first paragraph, as to the written description requirement.

As an initial matter, claim 16 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 16.

With respect to claims 21, 23, and 25, it is respectfully submitted that Figures 5 and 6 merely illustrate versions of exemplary embodiments. Thus, it is respectfully submitted that one of ordinary skill in the art would understand that the discussion of electrical insulation layers in the Specification at page 4, lines 26 to 32, a third layer in the Specification at page 3, lines 5 to 12, and at least one further layer in the Specification at page 2, line 36 to page 3, line 3 may apply to other versions of exemplary embodiments.

Accordingly, it is respectfully submitted that claims 21, 23, and 25 are allowable.

It is therefore respectfully requested that the rejection be withdrawn.

### **III. Rejection of Claim 26 Under 35 U.S.C. § 102(b) or 103(a)**

Claim 26 was rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over, U.S. Patent No. 5,879,525 ("Kato"). It is respectfully submitted that Kato does not anticipate, or in the alternative, render unpatentable, the present claim for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d

1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 26 relates to a method for producing a sensor element constructed in layers for detecting a physical property of one of a gas and a liquid and includes, inter alia, the features of *forming, in the first layer, a recess in a region of the contact face, in which the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element.*

Kato does not identically disclose, or even suggest, the feature that the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element. Instead, Kato repeatedly and consistently shows a diffusion control passage 12 that is narrower than a first internal cavity 6 or internal space 44. Kato, Figures 1a, 2a, and 5a. Accordingly, Kato indicates the opposite of, and thus teaches away from, the features of the present claims.

Accordingly, Kato does not identically disclose, or even suggest, all of the features included in claim 26. As such, it is respectfully submitted that Kato does not anticipate, or in the alternative, render unpatentable, claim 26.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 13 to 16, and 19 to 25 Under 35 U.S.C. § 103(a)**

Claims 13 to 16, and 19 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,294,679 (“Maurer et al.”), U.S. Patent No. 4,334,974 (“Muller et al.”), and U.S. Patent Application Publication

No. 2002/0164897 (“Liang”). Claim 16 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 16. It is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not render unpatentable the presently pending claims for at least the following reasons.

Claim 13 relates to a sensor element for detecting a physical property of one of a gas and a liquid and includes, inter alia, the features of *at least one contact face disposed in a layer plane between the first and second layers, the first layer including a recess in a region of the at least one contact face, in which the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element.*

As admitted in the Office Action of April 11, 2008 at page 9 and essentially repeated in the Final Office Action of September 15, 2008 at pages 6 to 7, “Maurer and Muller fail to disclose the slotlike-shaped recess widens toward the outer face of the sensor element.” Further, Liang also does not disclose, or even suggest, the feature that the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element, and thus, fails to cure this critical deficiency.

Liang merely indicates a terminal connector with a Y-shaped opening and a slot, which pierces the outer insulation layer of an inserted wire. Liang, ¶ 21. Thus, the terminal connector of Liang acts as an electrical contact for the pierced, inserted wire. In contrast, the first layer of the present claims does not provide electrical contact, but instead, includes a recess that exposes at least one contact face. As a result, one of ordinary skill would not be motivated to use the electrical connector of Liang in place of the first layer of the present claims, since such a substitution would cause the first layer of the present claims to be an electrical connector, which is contrary to the present application. Accordingly, there is no teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings, and there is also no reasonable expectation of success by combining the reference teachings. Therefore, Liang does not disclose a sensor element including, inter alia, a first layer, a second layer, and at least one contact face, the first layer including a recess in a region of at least one contact face, in which the recess has a slotlike-shaped recess that widens toward an outer face of the sensor element.

Accordingly, it is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not disclose, or even suggest, all of the features included in claim 13. Therefore, it is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not render unpatentable claim 13 for at least the foregoing reasons.

As for claims 14, 15, and 19 to 25, which ultimately depend from claim 13 and therefore include all of the features included in claim 13, it is respectfully submitted that the combination of Maurer et al., Muller et al., and Liang does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 26 Under 35 U.S.C. § 103(a)**

Claim 26 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Maurer et al., Muller et al., Liang, and Kato. It is respectfully submitted that the combination of Maurer et al., Muller et al., Liang, and Kato does not render unpatentable the present claim for at least the following reasons.

As more fully set forth above, the combination of Maurer et al., Muller et al., and Liang does not disclose, or even suggest, the feature that the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element. Further, as more fully set forth above, Kato also does not disclose, or even suggest, the feature that the recess is formed as a slotlike-shaped recess that widens toward an outer face of the sensor element.

Accordingly, it is respectfully submitted that the combination of Maurer et al., Muller et al., Liang, and Kato does not disclose, or even suggest, all of the features included in claim 26. As such, it is respectfully submitted that the combination of Maurer et al., Muller et al., Liang, and Kato does not render unpatentable claim 26.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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